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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/732,901 | 12/09/2003 | Robert J. Fletterick | 407J-000610US | 6910 |

22798 7590 10/12/2006

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EXAMINER

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ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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EXAMINER

ART UNIT

PAPER

20060929

DATE MAILED:

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Commissioner for Patents

The amendment to claims filed on 7/19/2006 has been entered.

However, applicant has failed to make a complete response to the Restriction Requirement mailed out on 2/16/2006. Applicant has stated in their response received on 7/19/2006, that they elect in a "further restriction" steroid hormone receptors as the nuclear receptor. This response is considered incomplete because the requirement under the "further restriction" section has clearly required an election of a SPECIFIC NUCLEAR RECEPTOR, whereas electing steroid hormone receptors as the nuclear receptor is an election of a general group of nuclear receptors and fails to meet the election requirement of a specific nuclear receptor. It has been set forth in the previous office action that "each nuclear receptor protein is a differing protein having a differing sequence, a differing structure, and a differing biological activity" and therefore each constitutes a unique and distinct invention. "Therefore, an agonist, modulator, or specifically binding agent to one of the receptors is not expected to be an agonist, modulator, or specifically binding agent for a materially differing receptor and substantially differing searches are required. The methods of producing, identifying or using an agonist to one of the nuclear receptors will identify, produce or use differing products." Applicant is still required to elect a SPECIFIC NUCLEAR RECEPTOR.

However, upon further consideration the election requirement under the "further restriction" section will now be considered to be an election of species with the following requirements.

An election of a specific species of nuclear receptor is required. For example, a list of specific nuclear receptors is listed in claim 18. The species are considered distinct because each nuclear receptor protein is a differing protein having a differing sequence, a differing structure, and a differing biological activity. Therefore, an agonist, modulator, or specifically binding agent to one of the receptors is not expected to be an agonist, modulator, or specifically binding agent for a materially differing receptor and substantially differing searches are required. The methods of producing, identifying or using an agonist to one of the nuclear receptors will identify, produce or use differing products. Additionally, each of the subspecies is considered distinct for the same reasons.

However, if the elected species is one of the following nuclear receptors, then a further subspecies election is required:

- 1) thyroid hormone receptor
- 2) peroxisome proliferator activated alpha receptor
- 3) steroid hormone receptor

Subspecies requirement for group 1 species:

a) A thyroid hormone receptor beta that comprises residues 381, Aspartate 382, Glutamate 393, Glutamate 396, and Arginine 429 as in claim 6.

b) A thyroid hormone receptor beta that comprises residues Valine 322, Leucine 346, Leucine 368, and Valine 371 as in claim 8.

Subspecie requirement for group 2 species:

a) A peroxisome proliferator activated gama receptor that comprises residues Valine 390, Leucine 414, Leucine 436, and Methionine 439 as in claim 10.

b) A peroxisome proliferator activated gama receptor that comprises residues Alanine 381, Valine 405, Leucine 427, and Methionine 430 as in claim 9.

Subspecie requirement for group 3 species:

If applicant elects a steroid hormone receptor, then applicant must further elect a specific type of steroid hormone receptor as the subspecies. For example, claim 18 further lists the different type of steroid hormone receptors. If applicant elects any of the following subspecies, then a further subspecies election of the subspecies is required:

1) thyroid hormone receptor

2) peroxisome proliferator activated alpha receptor

Further Subspecie election requirement for group 1 subspecies:

a) A thyroid hormone receptor beta that comprises residues 381, Aspartate 382, Glutamate 393, Glutamate 396, and Arginine 429 as in claim 6.

b) A thyroid hormone receptor beta that comprises residues Valine 322, Leucine 346, Leucine 368, and Valine 371 as in claim 8.

Further Subspecie requirement for group 2 subspecies:

a) A peroxisome proliferator activated gama receptor that comprises residues Valine 390, Leucine 414, Leucine 436, and Methionine 439 as in claim 10.

b) A peroxisome proliferator activated gama receptor that comprises residues Alanine 381, Valine 405, Leucine 427, and Methionine 430 as in claim 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claims 1, 17-28, and 31-39 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

John S. Brusca 30 September 2026

JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER